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PTO/SB/17 (12-04)

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Effective on 12/08/2004.

Fees pursuant to the Consolidated Appropriations Act, 2005 (H.R. 4818).

FEE TRANSMITTAL For FY 2005

Applicant claims small entity status. See 37 CFR 1.27

TOTAL AMOUNT OF PAYMENT (\$)
250.00

Complete if Known

Application Number	10/016,831
Filing Date	12/12/2001
First Named Inventor	Mark Andrew Boys
Examiner Name	Hewitt II, Calvin L.
Art Unit	3621
Attorney Docket No.	P1364

METHOD OF PAYMENT (check all that apply)

Check Credit Card Money Order None Other (please identify): _____

Deposit Account Deposit Account Number: 50-0534 Deposit Account Name: Mark A. Boys

For the above-identified deposit account, the Director is hereby authorized to: (check all that apply)

Charge fee(s) indicated below Charge fee(s) indicated below, except for the filing fee
 Charge any additional fee(s) or underpayments of fee(s) under 37 CFR 1.16 and 1.17 Credit any overpayments

WARNING: Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization on PTO-2038.

FEE CALCULATION

1. BASIC FILING, SEARCH, AND EXAMINATION FEES

Application Type	FILING FEES		SEARCH FEES		EXAMINATION FEES		
	Fee (\$)	Small Entity Fee (\$)	Fee (\$)	Small Entity Fee (\$)	Fee (\$)	Small Entity Fee (\$)	Fees Paid (\$)
Utility	300	150	500	250	200	100	0
Design	200	100	100	50	130	65	0
Plant	200	100	300	150	160	80	0
Reissue	300	150	500	250	600	300	0
Provisional	200	100	0	0	0	0	0

2. EXCESS CLAIM FEES

Fee Description

Each claim over 20 or, for Reissues, each claim over 20 and more than in the original patent
 Each independent claim over 3 or, for Reissues, each independent claim more than in the original patent
 Multiple dependent claims

Total Claims	Extra Claims	Fee (\$)	Fee Paid (\$)	Multiple Dependent Claims	Small Entity Fee (\$)	Fee (\$)
0 - 20 or HP = 0	x 25	= 0		0	50	25

HP = highest number of total claims paid for, if greater than 20

Indep. Claims	Extra Claims	Fee (\$)	Fee Paid (\$)	Fee (\$)	Fee Paid (\$)
0 - 3 or HP = 0	x 100	= 0		0	0

HP = highest number of independent claims paid for, if greater than 3

3. APPLICATION SIZE FEE

If the specification and drawings exceed 100 sheets of paper, the application size fee due is \$250 (\$125 for small entity) for each additional 50 sheets or fraction thereof. See 35 U.S.C. 41(a)(1)(G) and 37 CFR 1.16(s).

Total Sheets	Extra Sheets	Number of each additional 50 or fraction thereof	Fee (\$)	Fee Paid (\$)
- 100 = 0	/ 50 = 0	(round up to a whole number) x 125 = 0		

4. OTHER FEE(S)

Non-English Specification, \$130 fee (no small entity discount)

Other: Filing a brief in support of an appeal

Fees Paid (\$)

0

250.00

SUBMITTED BY

Signature	/Donald R. Boys/	Registration No. (Attorney/Agent)	35,074	Telephone	831-726-1457
Name (Print/Type)	Donald R. Boys			Date	05/11/2006

This collection of information is required by 37 CFR 1.136. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 30 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

INVENTOR: Mark Andrew Boys

CASE: P1364

SERIAL NO.: 10/016,831

GROUP ART UNIT: 3621

FILED: 12/12/2001

EXAMINER: Hewitt II, Calvin L

SUBJECT: A Direct Passthrough System for Financial Contributions

PARTY IN INTEREST: Mark A. Boys and SoundStarts, Inc. both of Aromas, CA.

Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

Dear Sirs:

APPEAL BRIEF

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1.0

Real Party in Interest

The real party in interest are the parties listed above under **Party in Interest**.

2.0

Related Appeals and Interferences

This is an appeal from the Office Action of the Examiner dated February 09, 2006 rejecting claims 1-24, the only pending claims in the application. There are no related appeals of the claims in this case or interferences in the instant case.

3.0

Status of the Claims

Following is the status of all claims in the instant case:

1. Rejected - appealed in this brief; independent.
2. Rejected - appealed in this brief; dependent.
3. Rejected - appealed in this brief; dependent.
4. Rejected - appealed in this brief; dependent.
5. Rejected - appealed in this brief; dependent.
6. Rejected - appealed in this brief; independent.
8. Rejected - appealed in this brief; dependent.
9. Rejected - appealed in this brief; dependent.
10. Rejected - appealed in this brief; dependent.
11. Rejected - appealed in this brief; dependent.
12. Rejected - appealed in this brief; dependent.
13. Rejected - appealed in this brief; independent.
14. Rejected - appealed in this brief; dependent.
15. Rejected - appealed in this brief; dependent.
16. Rejected - appealed in this brief; dependent.
17. Rejected - appealed in this brief; dependent.

18. Rejected - appealed in this brief; dependent.
19. Rejected - appealed in this brief; dependent.
20. Rejected - appealed in this brief; dependent.
21. Rejected - appealed in this brief; dependent.
22. Rejected - appealed in this brief; dependent.
23. Rejected - appealed in this brief; dependent.
24. Rejected - appealed in this brief; dependent.

4.0 Status of Amendments

No amendments have been filed subsequent to the rejection of claims 1-24, the subjects of this appeal.

5.0 Summary of the Claimed Subject Matter

Following is a concise explanation of the subject matter defined in each of the four standing independent claims including their dependent claims.

5.1 Independent system claim 1

1. A system for managing donations comprising:

an Internet-connected server accessible by donors using an Internet browser (Fig. 1, 13; pg. 7, lines 10-11) ;

a data store (Fig. 1, 26) accessible to the server and storing information about individuals or families, pre-qualified for donations (pg. 8, lines 23-25; pg. 10 lines 5-20) and associated each with a specific account with a financial institution, the account enabling the potential donors to make contributions (Fig. 5; pg. 11 lines 7-15) and the pre-qualified individuals or families to withdraw donated funds (pg. 4, lines 3-8; pg. 17, lines 5-9); and

software executing on the server Fig. 1, 12; pg. 3line 29 –pg. 4, line 2), enabling

the donors to obtain specific information about the pre-qualified individuals or families, and also enabling the donors to select one or more of the pre-qualified individuals or families and to make donations to the specific accounts associated with the selected pre-qualified individuals or families.

In summary, the above claim provides a system which associates an individual or family in need with a specific account at a financial institution in which a donor may select the individual or family for contribution, donating funds to the selected individual or family by donating funds to their associated account.

5.2 Independent method claim 13

13. (Previously presented) A method for managing donations, comprising the steps of:

- (a) providing an Internet-connected server accessible by donors using an Internet browser (Fig. 1, 13; pg. 7, lines 29-30);
- (b) providing a data store accessible to the server and storing information about individuals and families pre-qualified for donations (Fig. 1, 26; pg. 10, lines 5-20); and
- (c) executing a software suite in the server, enabling a donor to obtain specific information about the pre-qualified individuals and families, and to select one or more of the pre-qualified individuals or families and to make a donation directly to an account associated with the selected individual or family (pg. 11, lines 7-15; pg. 14, lines 3-13).

In summary, the above claim provides a method for a contributor to select a pre-qualified individual or family in need and make a donation directly to an account associated with said individual or family by interacting with an Internet connected server having specific software to facilitate the transaction.

6. Grounds of Rejection to be Reviewed on Appeal

Claims 1 is finally rejected under 35 U.S.C. 112. Claims 1-7 and 13-19 are finally rejected on the merits under 35 U.S.C. 103(a) as unpatentable over Gruber et al. (US App. 2002/0029179) hereinafter Gruber. Claims 8-12 and 20-24 are finally rejected under 35 U.S.C. 103(a) as being unpatentable over Gruber in view of Cohen (US Pat. 6,422,462) hereinafter Cohen.

7. Argument

Following is a presentation of arguments against the rejection put forth by the Examiner.

7.1 35 U.S.C. 112 against claim 1.

Claims 1 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The Examiner's Arguments:

The Examiner states that Claim 1 recites “a data store accessible to the server and storing information about individuals, or families, pre-qualified for donations and associated each with a specified account with a financial institution...” however, it is unclear what the Applicant means by “associated each”.

Claims 2-12 are also rejected as they depend from claim 1.

Appellant's response:

The applicant contends that the language is perfectly clear to the person with ordinary skill in the art, and grammatically correct. Each individual or family is associated with a specific account with a financial institution. That is, there is a bank

account in the name of the person or family. The applicant contends that the language of "...a person being associated with a specific account with a financial institution..." would be difficult to misconstrue by a person with ordinary skill in the art.

7.2 35 U.S.C. 103(a) against claims 1 and 13.

The Examiner's Arguments:

The Examiner states that Gruber et al. teaches a system for direct donation comprising:

- server accessible by potential donors (figure 1)
- data store accessible to the server and storing information about recipients pre-qualified to receive donations (figures 1,2, and 8-10)
- software suite enabling a donor to view information about recipients and enabling a donor to make a donation to the selected recipient (figures 2 and 8-10)
- setting up accounts for donors and recipients interacting with a financial institution for crediting a recipient account and debiting a donor account (figures 5 and 6).

Gruber et al. does not specifically recite individuals or families. However, to one of ordinary skill, a charitable organization can be a large (e.g. UNICEF), a single individual, or any size in-between (figures 8 and 9), therefore the prior art at least suggests storing information about recipients such as individuals or families.

Gruber et al. teach a method and system for making donations comprising a donor visiting the website of a charitable organization (i.e. internet connectable server) wherein the website stores information about the organization (e.g. data store accessible to the server) and allows donors to make donations at the website (figure 8). To one of ordinary skill, Gruber et al. teach an account associated with a financial institution that enables donors to make donations and pre-qualified recipients to make withdrawals, as a donor

can choose to have funds drawn electronically from a donor's credit card account (figure 6; column 4, paragraph [0048]), which necessitates a corresponding recipient account for receiving the drawn funds.

Regarding "individuals or families", the Gruber et al. system is directed to the broad class of "charitable organizations" (figure 8). Therefore, Gruber et al. can be used to accept donations for causes ranging from school endowments, medical research, military personnel, UNICEF, and political campaigns. To one of ordinary skill, a political campaign represents an individual pre-qualified to receive contributions (figure 3; column 3, paragraph [0036]).

Appellant's response:

In applicant's claimed system individual families or persons, pre-qualified for direct donations, are presentable to a potential donor. The claimed system in conjunction with financial institutions create a joint bank account between the individual & family and the donor, wherein the individual or family is associated with a bank account to which the potential donor may donate money, and from which the qualified person or family may withdraw the donated funds. The ownership of the money donated never resides in an intermediary, such as Gruber or the American Red Cross. The donor may provide funds directly to the individual or family, and a qualified person may withdraw the funds without permission from any intermediary.

Appellant argues that Gruber only teaches aspects regarding the donor and how the donor contributes. There is absolutely no teaching or suggestion in the art of Gruber to teach pre-qualifying individuals, creating a joint account between the donor and the individual recipient wherein the donor donates to the account and the individual may withdraw from the same account. There is no motivation in the art of Gruber to suggest pre-qualifying individuals or families for donations and associating each with a specific bank account with a financial institution, the account enabling the potential donors to make contributions and the pre-qualified individuals or families to withdraw donated funds.

The Examiner's contention that the limitation in claim 1 to a pre-qualified individual or family associated with an account at a financial institution to which a donor may contribute and from which the individual or family may withdraw funds, does not distinguish over an organization like the American Red Cross that collects money from donors, keeps the money in accounts controlled by the organization, and exercises complete control over who may get money and when and how, is very hard to understand. The distinguishing difference is clearly in who is in control of the money. In the prior art, and in all of the art cited by the Examiner, there is no direct donation that may be accessed (withdrawn) by a pre-qualified individual or family.

Appellant argues that the Examiner's reasoning for obviousness is not logical and lacks motivation. The recipient account in the art of Gruber is not facilitated by the system, nor does it belong to the recipient. The Examiner is clearly adding subject matter to the interpretation of the teachings of Gruber that are simply not there.

Regarding "individuals or families", the Examiner's reasoning also fails. The Examiner states that to one of ordinary skill, a political campaign represents an individual pre-qualified to receive contributions (figure 3; column 3, paragraph [0036]). Appellant argues that Gruber specifically teaches that organizations available for donors to contribute are specifically business entities (pg. 3 [0036]). Gruber does not contain any teaching that a pre-qualified individual can make a withdrawal from an account into which the donor has directly deposited money. The Examiner also mentions a Web site accepting donations for fallen police officer Robert J. Mata. The Web site is no longer active so Appellant is unable to view it. Further, there is no teaching that an account has been created by the system specifically for the fallen officer or his family enabling a donor to contribute to and an individual recipient to withdraw.

Regarding applicant's software limitations, they seem to not have been addressed in the Examiner's rejection in the most recent Office Action. In the previous Action the Examiner stated that "these tasks are never actually performed and the software merely enables the task to occur or potentially occur ("to be", "may be" or "enable" language). To one of ordinary skill, a server is a computer, and a computer utilizes software such as an

operating system, that *enables* the server to be *programmed* to perform numerous tasks (e.g. search databases, pay for goods and services, send email and play music online). Hence, the server of Gruber et al. necessarily comprises Applicant's *enabling* software."

Appellant argues that the Examiner ignores that clear fact that in the recited claim the programming is a fact, and stated as a limitation, not an intention. It is notoriously settled practice in the USPTO that a computer enhanced with software that performs a specific function is a new machine, and that functional limitation of computerized machines is correctly done by such recitation. The Examiner's contention that this language merely indicates that "programming might be done" is unarguably in error. The functions performed by the software are positively claimed. The language of the claim limits the invention to a system that actually performs these functions.

Regarding dependent claims 4 and 16, there is no mention or suggestion in the art of Gruber wherein a donation made by a donor to an account associated with a pre-qualified individual or family results in a withdrawal of the donated amount by the individual or family from an account associated with the donor.

Appellant argues that without the express teachings of appellant's specification, the Examiner is not capable of giving valid reasoning for obviousness. The Examiner's motivation for his reasoning is based on the teachings of appellant's specification, not the teachings of Gruber, or what is generally known by one with skill in the art.

re: dependent claims 2-12 and 14-24

Appellant asserts that as the independent claims 1 and 13 are shown to be patentable over the art of Gruber. Appellant asserts that a proper rejection, under 35 U.S.C. 103, is not supported by the reference of Gruber, because claimed limitations, which expand on the recipient side of the system are not remotely shown or suggested in the reference Gruber.

Appellant therefore strongly believes that all of the claims standing are clearly and unarguably patentable over the art. Accordingly, appellant respectfully requests that the Board reverse the rejection of the claims and hold the claims allowable.

8.

Claims Appendix

The claims involved in the appeal are:

1. (Previously presented) A system for managing donations comprising:
an Internet-connected server accessible by donors using an Internet browser;
a data store accessible to the server and storing information about individuals or families, pre-qualified for donations and associated each with a specific account with a financial institution, the account enabling the potential donors to make contributions and the pre-qualified individuals or families to withdraw donated funds; and
software executing on the server, enabling the donors to obtain specific information about the pre-qualified individuals or families, and also enabling the donors to select one or more of the pre-qualified individuals or families and to make donations to the specific accounts associated with the selected pre-qualified individuals or families.
2. (Previously presented) The system of claim 1 wherein the pre-qualified individuals or families are organized into project groups, and projects are listed as selectable entities, which, when selected, allow the selecting donors to obtain information about the pre-qualified individuals or families associated with the selected project.
3. (Previously presented) The system of claim 1 further comprising an interactive voice response (IVR) system through which a donor may interact with the system by telephone to obtain the specific information associated with the pre-qualified individuals or families.
4. (Previously presented) The system of claim 1 wherein a donation made by a donor to an account associated with a pre-qualified individual or family results in a withdrawal of the donated amount from an account associated with the donor.

5. (Previously presented) The system of claim 4 wherein the software executing on the server enables donors and individuals and families to set up accounts at financial institutions, the accounts then associated with the system.
6. (Previously presented) The system of claim 5 wherein the software enables donors and individuals and families to view account information in the accounts set up.
7. (Previously presented) The system of claim 1 wherein the software executing on the server enables individuals and families to provide information to the system to be processed by the system to pre-qualify the individuals and families, which may then be presentable by the system to donors.
8. (Previously presented) The system of claim 1 wherein the software enables non-cash donations to be made to the pre-qualified individuals and families from cash donations made by donors.
9. (Original) The system of claim 8 wherein the non-cash donations are made in the form of documents redeemable at pre-qualified and cooperating sites for goods and services.
10. (Original) The system of claim 9 wherein the documents take the form of cards issued for a total amount and redeemable in portions of the total amount until the total amount is redeemed.
11. (Previously presented) The system of claim 9 wherein the documents are associated with the specific individuals and families by an identification procedure, and are non-transferable.
12. (Previously presented) The system of claim 11 wherein the identification procedure comprises creating a virtual identity for a pre-qualified individual or family and issuing a

second document bearing the virtual identity, which must be associated with the redeemable document to implement redemption of any portion of the associated donation.

13. (Previously presented) A method for managing donations, comprising the steps of:

- (a) providing an Internet-connected server accessible by donors using an Internet browser;
- (b) providing a data store accessible to the server and storing information about individuals and families pre-qualified for donations; and
- (c) executing a software suite in the server, enabling a donor to obtain specific information about the pre-qualified individuals and families, and to select one or more of the pre-qualified individuals or families and to make a donation directly to an account associated with the selected individual or family.

14. (Previously presented) The method of claim 13 wherein the pre-qualified individuals or families are organized into project groups, and projects are listed for a donors as selectable entities, which, when selected, allow the selecting donor to obtain information about the pre-qualified individuals or families associated with the selected project.

15. (Previously presented) The method of claim 13 further comprising an interactive voice response (IVR) system through which a donor may interact with the system by telephone.

16. (Previously presented) The method of claim 13 wherein a donation initiated by a donor for a selected individual or family results in a withdrawal of the donated amount from an account associated with the donor.

17. (Previously presented) The method of claim 16 wherein the software enables setting up accounts at financial institutions for donors and individuals and families.

18. (Previously presented) The method of claim 17 account details may be displayed on demand to either of donors and individuals and families.
19. (Previously presented) The method of claim 13 wherein the software enables individuals and families to register with the system and provide information, and processes the information to pre-qualify the individuals or families.
20. (Previously presented) The method of claim 13 wherein the software enables non-cash donations to be made to pre-qualified individuals and families for cash donations made by donors.
21. (Original) The method of claim 20 wherein the non-cash donations are made in the form of documents redeemable at pre-qualified and cooperating sites for goods and services.
22. (Original) The method of claim 21 wherein the documents take the form of cards issued for a total amount and redeemable in portions of the total amount until the total amount is redeemed.
23. (Previously presented) The method of claim 21 wherein the documents are associated with pre-qualified individuals and families by an identification procedure, and are non-transferable.
24. (Previously presented) The method of claim 23 wherein the identification procedure comprises creating a virtual identity for an individual or family and issuing a second document bearing the virtual identity, which must be associated with the redeemable document to implement redemption of any portion of the associated donation.
- 25-26. (Canceled)

9.

Evidence Appendix

No evidence other than the arguments and facts presented in this brief is provided.

10.

Related Proceedings Appendix

No copies provided, because these claims have never been appealed.

Respectfully Submitted,
Mark Andrew Boys

By Donald R. Boys
Donald R. Boys
Reg. No. 35,074

Central Coast Patent Agency
P.O. Box 187
Aromas, CA 95004
(831) 726-1457



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Ref: Case Docket No.: **P1364**

First Named Inventor: **Mark Andrew Boys**

Serial Number: **10/016,831**

Filing Date: **12/12/2001**

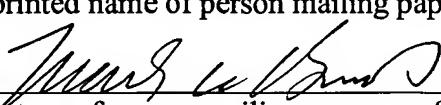
Title of Case: **A Direct Passthrough System for Financial Contributions**

I hereby certify that the attached papers are being deposited with the United States Postal Service "Express Mail Post Office to Addressee" service under 37 C.F.R. 1.10 on the date indicated above and addressed to the Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

1. Appeal Brief.
2. Fee transmittal.
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4. Check for fees in the amount of \$250.00.
5. Certificate of express mailing.
6. Postcard listing contents.

Mark A. Boys

(Typed or printed name of person mailing paper or fee)



(Signature of person mailing papers or fee)